

REMARKS

This responds to the Office Action mailed on December 19, 2008.

Claims 1, 9, 17, 23, 25, 32, and 35 are currently amended, claims 2, 6, 18, 22, 24, 28, 31, and 33 have previously been cancelled, claim 21 is currently cancelled, and claims 50 – 57 are added; as a result, claims 1, 3-5, 7-17, 19-20, 23, 25-27, 29-30, 32, and 34-57 are now pending and subject to examination in this application.

Interview Summary

The Applicant expresses its gratitude to the Examiner Ms. Lena Najarian for the courtesies extended to its representative Mr. David D’Zurilla during a telephonic interview on March 3, 2009.

Ms. Najarian and Mr. D’Zurilla discussed the rationales used in the Office Action for rejecting the claims under section 103. Mr. D’Zurilla pointed out the case of *Schneck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), which is noted in the MPEP in § 2141.02, and requested that Examiner Najarian consider the impact of this case on the instant matter. Examiner Najarian stated that she believed that the claims were too broad, and that the Applicant should consider narrowing the claims. Mr. D’Zurilla stated that he would take that into consideration in drafting a response to the current Office Action.

No agreement on the claims was reached.

§ 103 Rejection of the Claims

The pending claims were rejected under 35 U.S.C. § 103(a) as being obvious over Ballantyne et al. (U.S. Patent No. 5,867,821) in view of several other references, in particular Evans (U.S. Patent No. 5,924,074) and Kilgore et al. (U.S. Publication No. 2002/0072911).

Independent claims 1, 23, and 32 have been amended to recite that “one of the ergonomic actuators generates a customizable information screen that permits a medical provider to customize medical test results that are electronically displayed on the display screen.” Support for this amendment can be found in the specification on page 17, lines 15-22. The Applicant

respectfully submits that this places claims 1, 23, and 32 in a condition for allowance, and respectfully requests a notice to that effect.

Independent claims 9, 17, 25, and 35 have been amended to recite that “one of the ergonomic icons provides access to a search engine that searches one or more medical reference databases.” Support for this amendment can be found in the specification at page 26, lines 3-18, and in claim 21, which has been cancelled in connection with this amendment. In rejecting claim 21, the Final Office Action cited column 5, lines 42-51 of Ballantyne. The Applicant respectfully submits that this portion of Ballantyne relates to a video on demand service with which a user can view on a certain bandwidth of channels video movies, video games, music videos, and educational and training material such as information on the feeding and bathing of newborns and data on new pharmaceuticals. The Applicant respectfully submits that such VOD service is not a search engine that provides access to a medical reference database. The Applicant respectfully submits that independent claims 9, 17, 25, and 35 are in a condition for allowance, and respectfully requests a notice to that effect.

Newly added claim 50 is equivalent to claim 1 prior to the present amendments to claim 1. As noted in the Applicant’s response of December 8, 2008, the Applicant respectfully submits that a *prima facie* case of obviousness has not been established for claim 1 because the rationale for making the combination is faulty.

Specifically, the rationale provided in the Office Action for combining Ballantyne et al., Evans, and Kilgore et al. does not establish a *prima facie* case of obviousness. First, the Office Action states that such a combination would have been obvious to one of skill in the art because there would have been a motivation to organize patient data. However, the Appellant respectfully submits that such a general motivating factor cannot establish a *prima facie* case of obviousness.¹ Moreover, the Office Action fails to point out any relevant relationship between an ergonomic indicator that is large enough to be actuated by a user’s finger and the organization of patient data. The Applicant respectfully submits that there is no relevant relationship. That is,

¹ See *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (There must be objective evidence and specific factual findings with respect to the motivation to combine references). See also *Ecologhem v. Southern California Edison Co.*, 277 F.3d 1361, 1372 (Fed. Cir. 2002) (broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence of obviousness).

patient data can be organized just as easily whether a pen-based technology is used or a finger-based technology is used. Consequently, the rationale of the Office Action fails, and with that failure so goes the argument in the Office Action that it would have been obvious to one of skill in the art to combine the references of record.

Secondly, the rationale put forth in the Office Action contends that one of skill in the art would have been motivated to combine the cited references because it would have allowed a user to activate certain functions by touching portions of the screen. The Applicant respectfully submits that this rationale, like the previous rationale, fails to establish a *prima facie* case of obviousness. At least one problem with this rationale is that both the Evans and Kilgore references provide touch-type interfaces---one for large screens and the other for small screens. So, one of skill would not be lead to combine the references on the basis of touch screen capability, because each of them already had touch screen capability. Moreover, the references conflict regarding the size of the screens for which finger-actuated icons are suitable. The Applicant respectfully submits that it would not have been obvious to one of skill in the art to combine conflicting references. Consequently, the Office Action has failed to establish a *prima facie* case of obviousness, and the Applicant respectfully submits that claim 50 is allowable over the cited references.

Additionally, as noted in the telephonic interview of March 3, 2009, the Applicant would like to direct the Examiner's attention to the case of *Schneck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), which is noted in the MPEP in § 2141.02. In *Schneck*, the alleged infringer argued the claimed invention was obvious because it just made integral what had been made in the prior art as four bolted pieces. The Federal Circuit rejected this argument stating that it improperly limited the focus to structural differences of the claimed invention and the prior art, and failed to consider the invention as a whole. The Federal Circuit further stated that while the prior art perceived a need for mechanisms to dampen resonance, the inventor eliminated the need via the claimed one-piece gapless support structure.

Similarly, relating to claim 50, the Office Action has basically argued that the Applicant is only combining Ballantyne, Evans, and Kilgore. However, just like the inventor in *Schneck* who ignored the teaching of the prior art that there was a need to minimize dampening, the

inventors here ignored the teaching of the prior art that touch screens of mobile devices needed a stylus so that the icons on the screen could be small and use up less space on the small mobile device screen. Therefore, the Applicant submits that when considering the invention of claim 50 as a whole, and not simply the separate pieces thereof, the conclusion should be that claim 50 as a whole was not obvious to one of skill in the art at the time that the invention was made.

Newly added claims 51, 54, and 56 recite that “one of the ergonomic icons provides access to a search engine that searches one or more medical reference databases.” This feature is recited in independent claims 9, 17, 25, and 35, and the Applicant respectfully submits that claims 51, 54, and 56 are allowable over the cited art for at least the same reasons outlined above in connection with claims 9, 17, 25, and 35.

Newly added claims 52, 53, 55, and 57 recite that “one of the ergonomic icons generates a customizable information screen that permits a medical provider to customize medical test results that are electronically displayed on the display screen.” This feature is recited in independent claims 1, 23, and 32, and the Applicant respectfully submits that newly added claims 52, 53, 55, and 57, like claims 1, 23, and 32, are allowable over the cited art.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 371-2140 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 17, 2009.

/ Jonathan Ferguson /

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